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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
.09/690,199	10/16/2000	Billy P. Taylor	28150.7	2251

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EXAMINER

EL CHANTI, HUSSEIN A

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 06/07/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

PR2

Office Action Summary	Application No.	Applicant(s)	
	09/690,199	TAYLOR, BILLY P.	
	Examiner	Art Unit	
	Hussein A El-chanti	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This action is responsive to communication received on April 15, 2004. Claims 1, 3-5, 8, 10-12, 15 and 17-19 were amended. Claims 1-21 are pending examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Milovanovic et al., U.S. Patent No. 6,484,198 (referred to hereafter as Milovanovic).

As to claim 1, Milovanovic teaches a method performed by a computer system comprising:

storing a version of a mass-produced printed paper (see col. 5 lines 1-7 and col. 1 lines 46-50 and lines 29-37); and

forming a reference within the version, wherein the reference is a hyperlink associated with an operation and at least a portion of the version, wherein the version is displayable on a display device as a likeness of the paper and wherein the portion is selectable to cause performance of the operation (see col. 1 lines 60-64, col. 2 lines 11-24 and col. 3 lines 33-37).

As to claim 2, Milovanovic teaches the method of claim 1 wherein the forming comprises:

forming the reference within the version wherein the portion is displayable on the display device as a likeness of an advertisement within the paper (see col. 1 lines 60-64).

As to claim 3, Milovanovic teaches the method of claim 2 wherein the forming comprises:

forming the reference within the version wherein the hyperlink specifies a website associated with the advertisement (see col. 2 lines 11-24).

As to claim 4, Milovanovic teaches the method of claim 1 wherein the forming comprises:

forming the reference within the version wherein the hyperlink specifies a website and wherein the operation includes displaying the website (see col. 2 lines 11-24).

As to claim 5, Milovanovic teaches the method of claim 1 wherein the forming comprises:

forming the reference within the version wherein the reference specifies a file and wherein the operation includes displaying a visual image in response to the file (see col. 3 lines 50-57 and col. 2 lines 34-36).

As to claim 6, Milovanovic teaches the method of claim 1 wherein the forming comprises:

forming the reference within the version wherein the reference specifies a file and wherein the operation includes outputting audio signals in response to the file (see col. 2 lines 34-36).

As to claim 7, Milovanovic teaches the method of claim 1 wherein the forming comprises:

forming the reference within the version wherein the reference specifies a script and wherein the operation includes executing the script (see col. 2 lines 46-57).

As to claim 8, Milovanovic teaches a system comprising:

storing a version of a mass-produced printed paper (see col. 5 lines 1-7 and col. 1 lines 46-50 and lines 29-37); and

forming a reference within the version, wherein the reference is a hyperlink associated with an operation and at least a portion of the version, wherein the version is displayable on a display device as a likeness of the paper and wherein the portion is selectable to cause performance of the operation (see col. 1 lines 60-64, col. 2 lines 11-24 and col. 3 lines 33-37).

As to claim 15, Milovanovic teaches a computer program product comprising a computer program processable by a computer system for causing the computer system to:

store a version of a mass-produced printed paper (see col. 5 lines 1-7 and col. 1 lines 46-50 and lines 29-37); and

form a reference within the version, wherein the reference is a hyperlink associated with an operation and at least a portion of the version, wherein the version is

displayable on a display device as a likeness of the paper and wherein the portion is selectable to cause performance of the operation (see col. 1 lines 60-64, col. 2 lines 11-24 and col. 3 lines 33-37); and

an apparatus from which the computer program is accessible by the computer system (see col. 1 lines 60-64, col. 2 lines 11-24 and col. 3 lines 33-37).

3. Claims 9-14 and 16-21 do not teach or define any additional limitation over claims 1-7 and therefore are rejected for similar reasons.

4. Applicant's arguments filed have been fully considered but they are not persuasive.

In the remarks, the applicant argues in substance that; A) Milovanovic does not teach a reference to a likeness of a paper where the reference is a hyperlink.

In response to A) Milovanovic teaches a method of accessing an electronic copy of a newspaper or advertisement, where the user receives a URL that points to the location of the electronic version of the document. The URL or hyperlink has the location where the user can access to retrieve the electronic equivalent of the paper copy (see col. 2 lines 12-57) where the URL is considered to be the reference to the electronic version of the paper and therefore Milovanovic meets the scope of the claimed limitation "wherein the reference is a hyperlink associated with an operation and at least a portion of the version".

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A El-chanti whose telephone number is (703)305-4652. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703)308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hussein El-chanti
May 20, 2004


ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100